



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/820,022	04/08/2004	Zipora Brown	1330.1022CC	7563
21171	7590	03/12/2008	EXAMINER	
STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			MERCHANT, SHAHID R	
			ART UNIT	PAPER NUMBER
			3692	
			MAIL DATE	DELIVERY MODE
			03/12/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/820,022

Applicant(s)

BROWN ET AL.

Examiner

SHAHID R. MERCHANT

Art Unit

3692

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 December 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SG/US)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Status of the Claims

1. This action is in response to the amendment filed on December 14, 2007.

Claims 1-16 are pending. Claims 7-9 have been amended.

Terminal Disclaimer

2. The terminal disclaimer filed on December 14, 2007 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of U.S. Patent No. 6,910,021 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Response to Arguments

3. Applicant's arguments, see page 6, filed December 14, 2007, with respect to claims 7-9 have been fully considered and are persuasive. The rejection of claims 7-9 under 35 U.S.C. 112 2nd paragraph has been withdrawn.
4. Applicant's arguments with respect to claims 1-16 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-16 rejected under 35 U.S.C. 103(a) as being unpatentable over Offset of Tax Refund Payments to Collect Past-Due Support; Proposed Rule by Richard L. Gregg (see PTO-892, Ref. U). Hereinafter Gregg.

7. As per claim 1, Gregg teaches a payment process interacting with an offset payment system, said process comprising: determining debt to be referred for offset responsive to debt selection criteria; determining a payment to be referred for offset responsive to payment selection criteria; and referring the debt and the payment to the offset payment system responsive to the determinations with the offset payment system performing an offset of the debt and the payment responsive to referral (see Ref. "U", page 41688). Gregg does not explicitly recite the use of computers to perform this method. However, Examiner notes that the applied reference has been interpreted and applied assuming basic knowledge of one of ordinary skill in the art. According to *in re Jacoby*, 135 USPQ 317 (CCPA 1962), the skilled artisan is presumed to know something more about the art than only what is disclosed in the applied references. Also, in *In re Bode*, 193 USPQ 12 (CCPA 1977), the court found that every reference relies to some extent on knowledge of persons skilled in the art to complement that, which is disclosed therein. As applied to Gregg, it is within the basic knowledge of a skilled artisan that computers are being used with databases to compare payee information with debtor information to determine a match and offset a payment. One

would be motivated to use computers because it would make the process fast and reliable.

8. As per claim 2, Gregg teaches the process of claim 1 as described above.

Gregg further teaches comprising updating automatically debt records responsive to an offset by the offset payment system (see Ref. "U", page 41688).

9. As per claim 3, Gregg teaches the process of claim 2 as described above.

Gregg further teaches wherein debt records comprise general ledger records (see Ref. "U", page 41688).

10. As per claim 4, Gregg teaches comprising: determining a payment to be referred for offset of a debt responsive to payment selection criteria; and referring the payment to an offset payment system responsive to the determination (see Ref. "U", page 41688). Gregg does not explicitly recite the use of computers to perform this method. However, Examiner notes that the applied reference has been interpreted and applied assuming basic knowledge of one of ordinary skill in the art. According to *in re Jacoby*, 135 USPQ 317 (CCPA 1962), the skilled artisan is presumed to know something more about the art than only what is disclosed in the applied references. Also, in *In re Bode*, 193 USPQ 12 (CCPA 1977), the court found that every reference relies to some extent on knowledge of persons skilled in the art to complement that, which is disclosed therein. As applied to Gregg, it is within the basic knowledge of a skilled artisan that computers are being used with databases to compare payee information with debtor information to determine a match and offset a payment. One would be motivated to use computers because it would make the process fast and reliable.

11. As per claim 5, Gregg teaches the process of claim 4 as described above.

Gregg further teaches comprising updating automatically debt records responsive to an offset by the offset payment system (see Ref. "U", page 41688).

12. As per claim 6, Gregg teaches the process interacting with an offset payment system, debt to be referred for offset payment responsive to debt selection criteria, referring the debt to an offset payment system responsive to the determination, determining, a payment to be referred for offset of a debt responsive to payment selection criteria, referring the payment to the offset payment system responsive to the determination, and updating debt records in the accounts system responsive to an offset by the offset payment system, and updating automatically payment records in the payable system responsive to the offset by the offset payment system (see Ref. "U", page 41688). Gregg does not explicitly recite storing a computer program on a computer readable medium to be executed by processor. However, Examiner notes that the applied reference has been interpreted and applied assuming basic knowledge of one of ordinary skill in the art. According to *in re Jacoby*, 135 USPQ 317 (CCPA 1962), the skilled artisan is presumed to know something more about the art than only what is disclosed in the applied references. Also, in *In re Bode*, 193 USPQ 12 (CCPA 1977), the court found that every reference relies to some extent on knowledge of persons skilled in the art to complement that, which is disclosed therein. As applied to Gregg, it is within the basic knowledge of a skilled artisan to store a computer program on a computer readable medium to be executed by processor that can compare payee information with debtor information to determine a match and offset

a payment. One would be motivated to store a computer program on a computer readable medium and use it with a computer because it would make the process fast and reliable.

13. As per claim 7, Gregg teaches a payment system, comprising: a financial management system determining debt to be referred for offset responsive to debt selection criteria; and an offset payment system, separate from the financial management system, receiving authorization for a payment, offsetting the payment with the referred debt and notifying said management system of an offset, and said management system updating a debt record responsive to the offset (see Ref. "U", page 41688). Gregg does not explicitly recite the use of computers to perform this method. However, Examiner notes that the applied reference has been interpreted and applied assuming basic knowledge of one of ordinary skill in the art. According to *in re Jacoby*, 135 USPQ 317 (CCPA 1962), the skilled artisan is presumed to know something more about the art than only what is disclosed in the applied references. Also, in *In re Bode*, 193 USPQ 12 (CCPA 1977), the court found that every reference relies to some extent on knowledge of persons skilled in the art to complement that, which is disclosed therein. As applied to Gregg, it is within the basic knowledge of a skilled artisan that computers are being used with databases to compare payee information with debtor information to determine a match and offset a payment. One would be motivated to use computers because it would make the process fast and reliable.

14. As per claim 8, Gregg teaches a payment system, comprising: a financial management system determining a payment to be made and subject to an offset

responsive to payment selection criteria; and an offset payment system, separate from the financial management system, receiving the authorization for a debt offset, offsetting the payment with the debt and notifying said management system of an offset, and said management system updating a payment record responsive to the offset. (see Ref. "U", page 41688). Gregg does not explicitly recite the use of computers to perform this method. However, Examiner notes that the applied reference has been interpreted and applied assuming basic knowledge of one of ordinary skill in the art. According to *in re Jacoby*, 135 USPQ 317 (CCPA 1962), the skilled artisan is presumed to know something more about the art than only what is disclosed in the applied references. Also, in *In re Bode*, 193 USPQ 12 (CCPA 1977), the court found that every reference relies to some extent on knowledge of persons skilled in the art to complement that, which is disclosed therein. As applied to Gregg, it is within the basic knowledge of a skilled artisan that computers are being used with databases to compare payee information with debtor information to determine a match and offset a payment. One would be motivated to use computers because it would make the process fast and reliable.

15. As per claim 9, Gregg teaches a payment system, comprising: a first financial management system providing accounts receivable functions determining debt to be referred for offset responsive to debt selection criteria, producing a debt offset authorization; a second financial management system providing accounts payable functions, separate from the first system and determining a payment to be made and subject to offset responsive to payment selection criteria and producing a payment

offset authorization; and an offset payment system, separate from the first and second financial management systems, receiving the debt and payment authorizations, offsetting the payment with the referred debt and notifying said first and second management systems of an offset, the first and second management systems updating automatically debt and payment records within the first and second financial management systems responsive to the offset (see Ref. "U", page 41688). Gregg does not explicitly recite the use of computers to perform this method. However, Examiner notes that the applied reference has been interpreted and applied assuming basic knowledge of one of ordinary skill in the art. According to *in re Jacoby*, 135 USPQ 317 (CCPA 1962), the skilled artisan is presumed to know something more about the art than only what is disclosed in the applied references. Also, in *In re Bode*, 193 USPQ 12 (CCPA 1977), the court found that every reference relies to some extent on knowledge of persons skilled in the art to complement that, which is disclosed therein. As applied to Gregg, it is within the basic knowledge of a skilled artisan that computers are being used with databases to compare payee information with debtor information to determine a match and offset a payment. One would be motivated to use computers because it would make the process fast and reliable.

16. As per claim 10, Gregg teaches a payment process interacting with an offset payment system, comprising: accessing debt selection criteria; determining debt to be referred for offset payment responsive to the debt selection criteria; and referring of the debt, to the offset payment system responsive to the determination (see Ref. "U", page 41688). Gregg does not explicitly recite the use of computers to perform this method.

However, Examiner notes that the applied reference has been interpreted and applied assuming basic knowledge of one of ordinary skill in the art. According to *in re Jacoby*, 135 USPQ 317 (CCPA 1962), the skilled artisan is presumed to know something more about the art than only what is disclosed in the applied references. Also, in *In re Bode*, 193 USPQ 12 (CCPA 1977), the court found that every reference relies to some extent on knowledge of persons skilled in the art to complement that, which is disclosed therein. As applied to Gregg, it is within the basic knowledge of a skilled artisan that computers are being used with databases to compare payee information with debtor information to determine a match and offset a payment. One would be motivated to use computers because it would make the process fast and reliable.

17. As per claim 11, Gregg teaches an offset process, comprising: determining, debt to be referred for offset; determining, a payment to be referred for offset; and referring the debt and payment to an offset payment system for offset and receiving a confirmation of an offset (see Ref. "U", page 41688). Gregg does not explicitly recite the use of computers to perform this method. However, Examiner notes that the applied reference has been interpreted and applied assuming basic knowledge of one of ordinary skill in the art. According to *in re Jacoby*, 135 USPQ 317 (CCPA 1962), the skilled artisan is presumed to know something more about the art than only what is disclosed in the applied references. Also, in *In re Bode*, 193 USPQ 12 (CCPA 1977), the court found that every reference relies to some extent on knowledge of persons skilled in the art to complement that, which is disclosed therein. As applied to Gregg, it is within the basic knowledge of a skilled artisan that computers are being used with

databases to compare payee information with debtor information to determine a match and offset a payment. One would be motivated to use computers because it would make the process fast and reliable.

18. As per claim 12, Gregg teaches an offset process, comprising: determining, debt to be referred for offset; determining a payment to be referred for offset; referring the debt and payment to an offset payment system for offset and receiving a confirmation of an offset; and performing multiparty accounting functions within each of the accounts receivable and payable systems allocating the offset to multiple sources and destinations (see Ref. "U", page 41688). Gregg does not explicitly recite the use of computers to perform this method. However, Examiner notes that the applied reference has been interpreted and applied assuming basic knowledge of one of ordinary skill in the art. According to *in re Jacoby*, 135 USPQ 317 (CCPA 1962), the skilled artisan is presumed to know something more about the art than only what is disclosed in the applied references. Also, in *In re Bode*, 193 USPQ 12 (CCPA 1977), the court found that every reference relies to some extent on knowledge of persons skilled in the art to complement that, which is disclosed therein. As applied to Gregg, it is within the basic knowledge of a skilled artisan that computers are being used with databases to compare payee information with debtor information to determine a match and offset a payment. One would be motivated to use computers because it would make the process fast and reliable.

19. As per claims 13-16, Gregg teaches sending notifications to the debtor of the offset, the payee of the offset and a third party of the offset (see Ref. "U", page 41689, column 2).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHAHID R. MERCHANT whose telephone number is (571)270-1360. The examiner can normally be reached on First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz P. Abdi can be reached on 571-272-6702. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SRM

/Kambiz Abdi/
Supervisory Patent Examiner, Art
Unit 3692

